

S/N 09/845,648

Docket: YOR920010396US1

REMARKS

Entry of this Request for Reconsideration is proper under 37 CFR §1.116, since no new claims or issues are raised and the comments hereinbelow clarify Applicants' position in preparation for Appeal, which comments will have to be addressed by the Examiner in the Examiner's Answer.

It is noted that, notwithstanding any claim amendments made during prosecution, Applicants' intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1-15 are all of the claims pending in the present Application. Claims 1-7, 9, 10 and 13-15 stand rejected under 35 US §102(b) as anticipated by US Patent 4,947,322 to Tenma et al. Claim 8 stands rejected under 35 US §103(a) as unpatentable over Tenma, further in view of the extract from Elmasri et al., "Fundamentals of Database Systems". Claims 11 and 12 stand rejected under 35 US §103(a) as unpatentable over Tenma/Elmasri, further in view of US Patent 5,774,868 to Cragun et al.

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

As described and claimed, for example by claim 1, the present invention addresses a computer method that provides a department store space-requirements database comprising a compendium of individual department store space-requirements history. A department store space-availability database is also provided, comprising a compendium of at least one of department store space management solutions, department store space information, and department store space diagnostics. A data mining technique interrogates the department store space-requirements and department store space-availability databases and generates an output data stream that correlates the department store space-requirements problem with department store space-availability solution.

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II. THE PRIOR ART REJECTION

The Examiner alleges that Tenma anticipates claims 1-7, 9, and 10, and, when combined with Elmasri, renders obvious claim 8, and when combined with Elmasri and Cragun, renders obvious claims 11 and 12.

Applicants disagree, as previously presented in the Amendment Under 37 CFR §1.111, filed on April 9, 2004. Applicants' arguments of that Amendment are not repeated below but these arguments will serve as elements of the Applicants' Appeal Brief.

The arguments hereinbelow augment these previous arguments, as reflecting the Applicants' answer to the Examiner's Response to Arguments as contained at pages 2-5 of the Office Action dated June 17, 2004.

Therefore, prior to imminent appeal, Applicants summarize below the four deficiencies in the Examiner's analysis currently of record, based on the Examiner's latest response.

1. First, Applicants submit that, even under the Examiner-supplied definition of "expert system", Tenma fails as fulfilling the requirements of that definition. That is, according to the Examiner's definition, an expert system is "an application program that makes decisions or solves problems" Applicants submits that the application program in Tenma merely performs the role of a calculator and lacks the capability to "make decisions or solve problems". Applicants submit that, in Tenma, it is the human user who supplies this role. Accordingly, Tenma cannot reasonably be considered an "expert system".

Applicants submit that, if the application program in Tenma autonomously performed the steps shown in Figure 2, then the Examiner might reasonably be able to classify the program as an expert system, since one could reasonably consider that these steps autonomously solve the problem of optimizing a layout of goods.

However, as Applicants have already pointed out, these steps are not executed autonomously by a computer. Rather, the human user is involved, as clearly stated in the text describing this figure.

Thus, as clearly described at lines 57-59 of column 4, in step 2, the user manually makes selections of goods to be deleted, using the mouse. As clearly described at line 60 of

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column 4 through line 23 of column 5 (e.g., steps 3 and 4), the application program then uses the rules stored in the knowledge base 14 and the information about the goods in layout table 11 to calculate a new layout of goods for the changes made by the user in step 2.

As clearly described at lines 23-35 of column 5, in step 5, the user then makes interactive modifications to the calculated layout, including "... deletion, addition, exchange, movement, and change of goods."

Applicants submit that this user-interaction precludes the application program in Tenma as being described as an "expert system" and, as Applicants have already stated, can only be described as a calculator that calculates a result of the user's modifications. This user-assisted operation of Tenma is confirmed in the description at line 65 of column 1 through line 2 of column 2 and at lines 13-18 of column 2.

2. Stated slightly differently, in accordance with the definition provided by the Examiner in the paragraph bridging pages 2-3 of the Office Action, the application program in Tenma lacks the component of an inference engine and fails to "make decisions or solve a problem". Rather, in Tenma, it is the user who provides the role of making decisions that solve the problem. The application program merely provides an automatic calculation of the optimal layout in accordance with the user's modifications, using the stored rules as its algorithm to calculate the revised layout.

3. Third, the description at lines 32-34 of column 1 clearly teach against modifying Tenma to become an autonomous application problem to automatically solve the optimal layout, since the stated purpose of these lines is that the planner specifically be able to make modifications to an automatic layout calculations. Again, these lines clearly describe that the decision maker in Tenma is the user, not the rules that provide the algorithm to calculate a layout resulting from the user's selections. This fact alone precludes the technique in Tenma from being described as an "expert system", as that term is understood by one of skill in the art.

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4. Fourth, the analysis currently of record fails to heed the plain meaning of the language of the claims. As previously pointed out, the plain meaning of the independent claims requires that there be two databases, a department store space-requirements database and a space-availability database.

The plain meaning of these claims also requires that the data mining technique interrogate the two databases to provide an output stream that correlates a department store space-requirements problem with a department store space-availability solution.

The closest correlation that Tenma reasonably provides is a "database" for space-availability, as provided by the contents of file 7 that describe the shelves of the gondola (e.g., see lines 20-28 of column 4). Thus, Tenma clearly fails to provide a second database corresponding to a space-requirements database.

Indeed, the problem to be solved in Tenma is the determination of the optimum quantity and layout of goods to be placed in this space. Thus, there is no second database listing the space-requirements of the gondola. The most that can be said of the technique in Tenma is that the same database describes both the space-requirements and the space-availability, clearly a contradiction of the plain meaning of the claim language.

Because there is no second database in Tenma, it goes without saying that there can be no correlation of the two databases, as clearly required by the plain meaning of the claim language.

Therefore, in spite of the arguably similarity purpose in Tenma of attempting to provide a solution to optimize space usage in a department store environment, it is clear that the basic structure of the tool used in Tenma fails to incorporate two databases and that the tool, therefore, inherently fails to correlate two databases.

The fact that Tenma contains a set of rules to serve as an algorithm to calculate a layout does not in any way overcome this basic deficiency that two databases do not exist in Tenma, thereby inherently providing the second basic deficiency in Tenma that there is no correlation of two databases.

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Hence, turning to the clear language of the claims, there is no teaching or suggestion of "... providing a department store space-requirements database comprising a compendium of individual department store space-requirements history; ii) providing a department store space-availability database comprising a compendium of at least one of department store space management solutions, department store space information, and department store space diagnostics; and iii) employing a data mining technique for interrogating said department store space-requirements and department store space-availability databases for generating an output data stream, said output data stream correlating a department store space-requirements problem with a department store space-availability solution", as required by the independent claims.

Therefore, Tenma clearly does not anticipate claims 1-7 and 9-10. Applicants maintain that the secondary references are not properly combinable with Tenma, for the reasons discussed in the previous Amendment.

For the reasons stated above, the claimed invention is fully patentable over the cited references.

Further, the other prior art of record has been reviewed, but it too, even in combination with Tenma, Elmasri, and Cragun, fails to teach or suggest the claimed invention.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-15, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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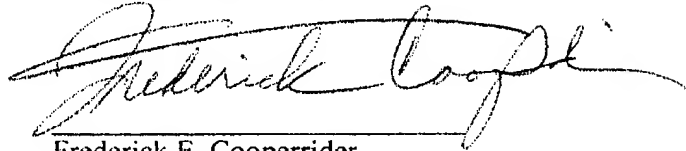
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date:

8/17/04



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Customer No. 21254**CERTIFICATION OF TRANSMISSION**

I certify that I transmitted via facsimile to (703) 872-9306 this Request for Reconsideration under 37 CFR §1.116 to Examiner H. Pham on August 17, 2004.



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8/17/04